

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

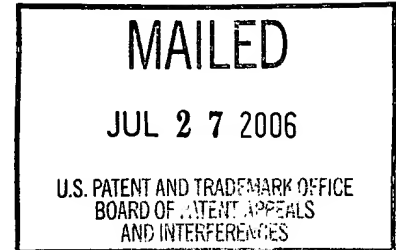
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte BALJEET SINGH BAWEJA, KULVIR SINGH BHOGAL,
NIZAMUDEEN ISHMAEL JR. and MANDEEP SINGH SIDHU

Appeal No. 2006-1724
Application No. 09/589,666

ON BRIEF



Before HAIRSTON, JERRY SMITH and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 4-18 and 23-34.

The disclosed invention pertains to a system and method of distributing condensed versions of displayable information in Hypertext Markup Language documents transmitted on the World Wide Web to personal palm-type display computers.

Representative claim 14 is reproduced as follows:

14. A computer program having code recorded on a computer readable medium for providing condensed versions of displayable information to personal palm-type computers connected to a World Wide Web communication network comprising:

- a Hypertext Markup Language document transmitted on said World Wide Web including:
 - a first set of natural language data conveying a first version of information of a particular content displayable to users at said receiving display stations, and
 - a second set of natural language data conveying a second version of condensed displayable information of the same particular content displayable to users of personal palm-type display computers connected to said remote locations; and
- means at a personal palm-type display computer with access to the World Wide Web for accessing said second set of natural language data from a received Hypertext Markup Language document.

The examiner relies on the following references:

Kikinis	U.S. Pat. 6,076,109	June 13, 2000
	Effective Filing date:	Jan. 30, 1997
Donoho et al. (Donoho)	U.S. Pat. 6,604,130	Aug. 5, 2003
	Effective Filing date:	Sep. 1, 1998

The following rejection is on appeal before us:

1. Claims 4-18 and 23-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Kikinis in view of Donoho.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the

examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived. See 37 C.F.R.

§ 41.37(c)(1)(vii)(2004).

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does not support the examiner's rejection of claims 4-18 and 23-34. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on

evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We consider the examiner's rejection of claims 4-18 and 23-34 that stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Kikinis in view of Donoho. We note that appellants initially present all of the pending claims (i.e., claims 4-18

and 23-34) under a separate subheading and argue these claims as a single group [brief, page 4]. Pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii)(2004), we will select claim 14 as the representative claim for this rejection because it is the broadest independent claim.

At the outset, we note that the primary Kikinis reference is directed to providing World Wide Web access to a field computer that has limited processing and/or display capabilities [col. 10, lines 5-46, fig. 4]. Kikinis teaches a system where downloaded web pages are transposed by an intermediate proxy server that reduces the information density of each HTML web page in a manner that accommodates the specific display size and resolution of the target field computer [Kikinis, col. 2, lines 31-67]. The reduced data is stored in an “HT-Lite” (HTL) format file on a proxy server for transmission to the handheld field computer [col. 10, lines 37-40; col. 13, lines 45-48].

The secondary Donoho reference is directed to the broadcast of advisories, where an advisory consists of information targeted for one or more subscribers who receive advisories from an information provider via the Internet [col. 2, lines 40-44; col. 3, lines 41-44]. Donoho teaches an advisory is a specially formatted ASCII file built using the Multipurpose Internet Mail Extensions (MIME) Internet standards specification [col. 14, lines 24-25]. Donoho discloses that MIME files are transported over the Internet and easily broken into constituent components using parsing algorithms that are well known in the Internet community [col. 14, lines 33-36]. We note, in particular, that Donoho supports communication over the Internet with handheld personal devices that appear to be similar to

the handheld battery-powered field computers disclosed by Kikinis [Donoho, col. 5, lines 17-31]:

The invention implements a process of communication which systematically solves the problem of linking an information provider to information consumer. The invention provides a system which depends on the use of computational devices connected by communications networks. In actual practice, these devices could range from traditional large-scale computers to personal computers to handheld personal information managers to embedded computational devices in the ambient environment, including consumer appliances such as remote controls and smart TVs, or other common computationally-dense environments, such as transportation vehicles. The communications mechanisms could include a modem or other wired media, or wireless communications, using the Internet or other protocols, and could include the physical distribution of media [Donoho, col. 5, lines 17-31, emphasis added].

I. Appellants argue that every claim in the instant application is patentable, asserting that every claim requires the transmission of a markup language document such as a Hypertext Markup Language (HTML) document containing two versions of the data content: a first version of the content which is displayable at standard display stations, and a condensed version of the same data content displayable on smaller palm-type displays [brief, page 4, reply brief, page 2]. Appellants further argue that the combination of references cited by the examiner does not provide a suggestion of means in the personal palm-type computer for directly accessing the second, i.e., condensed version of the displayable data from the received markup language document [brief, page 5, reply brief, page 3, emphasis added].

We note that the examiner asserts in the rejection that Kikinis teaches: “a means for accessing the second set of natural language data from a received Hypertext Markup Language document in fig. 4 and col. 2, lines 32-67,” this teaching corresponding to

downloaded data transposed from regular HTML Web pages to match the specific size and resolution of the display of the field computer [answer, page 4].

A basic canon of claim construction is that one may not read a limitation into a claim from the written description. Renishaw plc v. Marposs Societa' per Azioni, 158 F.3d 1243, 1248, 48 USPQ2d 1117, 1120 (Fed. Cir. 1998). Patentability is based upon the claims. “It is the claims that measure the invention.” SRI Int’l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). When making a patentability determination, the claimed invention must be compared to the prior art [emphasis added]. In particular, we note that the limitation “directly accessing” argued by appellants is not claimed [brief, page 5, 3rd line from bottom of page, reply brief, ¶2, 3rd line, emphasis added]. In contrast, the independent claims merely require accessing “said second set of natural language data” [claims 4, 9, 14, 23]. Accordingly, we find that appellants are impermissibly reading limitations found within the specification into the claims to avoid the prior art.

We agree with the examiner that Kikinis teaches means in the field computer (i.e., corresponding to the claimed personal palm-type computer) for accessing the second condensed version (i.e., corresponding to the “HT-Lite” (HTL) format file discussed *supra*) of the displayable data from the received markup language document [col. 10, lines 37-40; col. 13, lines 45-48, emphasis added].

We note that Kikinis explicitly discloses that information particular to specific characteristics of the field computer is used by the proxy server to transpose HTML data for transfer to the field computer [col. 2, lines 60-67; see also Fig. 4]:

Also in some preferred embodiments of the invention, when a field computer makes a data link with a Proxy-Server adapted according to embodiments of the invention, the field computer transfers to the Proxy-Server information particular to specific characteristics of the field computer, such as the size and resolution of the display of the field computer. The Proxy-Server then uses this information in transposing data for transfer to the field computer.

However, as pointed out by appellants, the examiner admits that Kikinis does not teach that two sets of natural language are combined and contained within the same markup language document file [brief, page 5, see also answer, page 4, emphasis added].

The examiner relies on the teachings of Donoho for this aspect, pointing out that Donoho teaches an alteration method which gives the power of selection to the receiving client where versions are combined into one single document [answer, page 11, ¶1; see also Donoho at col. 22, lines 15-22]. We note that the section of Donoho relied upon by the examiner discloses the following use of Multipurpose Internet Mail Extensions (MIME) [col. 22, lines 15-22]:

Alternation. MIME provides a method, i.e. Multipart-Alternate, for offering two different versions of the same message, with the destination picking the appropriate display method. Therefore, the invention construct of transmitting one or more ways to display the same information may easily be implemented using the MIME standard and its Multipart-Alternate feature.

We note that Donoho discloses that advisory messages may be broadcast and displayed using three formats: Text, HTML, and Text/HTML [col. 20, lines 24-40]:

The message body may occur in at least three forms:

Text. The explanatory material may be an unconstrained ASCII text document. This has no embedded variations in presentation style (e.g. no changes in font and/or no hypertext references to outside documents).

HTML. The explanatory material making up the message body may be an HTML document. This is familiar from Web browsers. HTML documents may contain variations in the presentation of text, may contain tables and visual formatting features, may contain references to external documents, and may contain references to external graphics files.

Text/HTML. The explanatory material making up the message body may be given in both text and HTML forms. The advice reader has the option of using whichever form is more appropriate to the user.

Significantly, we note that Donoho provides an example of an advisory file that uses the third Text/HTML broadcasting format where the MIME content type is explicitly designated by the header field "Content-Type: text/html" [col. 22, lines 58-67, cont'd col. 23, lines 1-8]:

The following is an example of an advisory file:

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Date: Sat Mar 21 1998 17:06:12+0800
From: Jeremiah Adviser <jeremiah@advisories.com>
MIME-Version 1.0
Organization: Universe Communications, Inc.
Subject: A better version of the advice reader is now available relevant-When: version
of application "advice.exe"<version "5.0"
Content-Type: text/html; charset=us-ascii
<HTML><BODY>
A better version of the advice reader is available.
Click to <A HREF="http://www.advisories.com/win98/advice50.exe">
Download </A>the latest version of advice reader.
</BODY></HTML>
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We find that Donoho's example Text/HTML advisory file clearly shows two versions of the same single-sentence natural language message (i.e., "A better version of the advice reader is available") as broadcast within a single file using a first plain text version of the

message, and a second HTML version of the message, as shown *supra* [col. 22, lines 58-67, cont'd col. 23, lines 1-8, emphasis added].

Thus, a close examination of the Donoho reference supports the examiner's reliance upon Donoho as offering two different versions of the same natural language message, where both versions are transmitted in a single HTML document (i.e., an advisory file), with the destination (i.e., client) picking the appropriate display method [answer, page 11, emphasis added]. We note that Donoho's example advisory file may be reasonably characterized as a Hypertext Markup Language document because it is clearly a file that contains some HTML content, as shown *supra* [emphasis added]. In fact, when an ASCII text file containing Donoho's example advisory file is read by a web browser (i.e., Internet Explorer), the web browser displays some of the plain text information in addition to the HTML content located between the paired <HTML></HTML> tags, as shown *infra*:

Actual Internet Explorer web browser display using Donoho's example advisory file:

Date: Sat Mar 21 1998 17:06:12+0800 From: Jeremiah Adviser MIME-Version 1.0 Organization: Universe Communications, Inc. Subject: A better version of the advice reader is now available relevant-When: version of application "advice.exe" A better version of the advice reader is available. Click to Download the latest version of advice reader.

In summary, Kikinis clearly teaches two sets or versions of natural language data (i.e., HTML and HTL) where the second set conveys a second version of condensed displayable content that is accessed and displayed to users of personal palm-type display computers

connected to remote locations, as required by the language of the representative claim [e.g., see Kikinis, col. 10, lines 31-46, also Fig. 4, emphasis added]. As admitted by the examiner, Kikinis does not teach that the two sets are combined into a single document [answer, pages 4 and 11, emphasis added]. However, as discussed *supra*, Donoho clearly teaches that two different versions of the same natural language message are combined into a single HTML document, with the destination (i.e., client) picking the appropriate display method [col. 22, lines 58-67, cont'd col. 23, lines 1-8]. Accordingly, we find that the examiner's proffered combination of Kikinis and Donoho clearly teaches all limitations of representative claim 14.

II. Appellants further argue that the extensive general disclosure of Donoho is not related to the present invention and that the Examiner has extracted a segment at col. 22, lines 15-22 which is only pertinent if interpreted in light of appellants' own teaching [brief, page 5].

Appellants note that the portion of Donoho relied upon by the examiner merely discloses an e-mail message with alternative versions, the selection of which is determined by the destination [*id.*]. Appellants conclude that this only means that Donoho's interpretive servers can select the appropriate version suitable to the needs of the advice consumer [*id.*].

Appellants further argue that the examiner's proposed combination of Kikinis and Donoho is being made not with the requisite foresight of one skilled in the art, but rather with hindsight obtained solely by the teaching of the present invention [brief, page 6, reply brief, pages 2 and 3]. Appellants conclude that the examiner has impermissibly used appellants' own disclosure as a guideline, and has picked and combined elements from each of the Kikinis

and Donoho references based solely upon appellants' own teaching [brief, pages 5 and 6, reply brief, pages 2 and 3].

The examiner disagrees, arguing that Donoho teaches that MIME is a communication standard widely used for the transport of messages on the Internet [answer, page 10]. The examiner asserts that because Kikinis discloses transporting web page information from a server to a client via the Internet, (as shown by Kikinis in figures 1 and 7), the examiner believes that the Internet transport teachings of Donoho are relevant and would have been known to one of ordinary skill in the art [*id.*]. The examiner further notes that Kikinis is concerned with two forms of originating information, a full version and a reduced version of the information [*id.*]. The examiner notes that Kikinis teaches another embodiment that uses e-mail messages (fig. 6 and col. 13, lines 23-30), and that this use of e-mail messages by Kikinis strengthens the examiner's belief that one of ordinary skill in the art would have had knowledge of the advantages of the MIME Internet transport standard at the time of the invention [*id.*]. Thus, the Examiner maintains that the motivation for combining Kikinis and Donoho comes directly from the references themselves and not solely in light of appellants' own teaching [*id.*].

There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor [emphasis added]. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000). "Determination of obviousness can

not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.” ATD Corp. v. Lydall, Inc., 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998). It is impermissible to use a claimed invention as a “template or guide” in order to piece together the teachings of prior art references which show only individual elements of the claimed invention in an effort to create a mosaic of such prior art to argue obviousness. In re Fritch, 972 F.2d 1260, 1265-6, 23 USPQ2d 1780, 1783-4 (Fed. Cir. 1992). Piecemeal reconstruction of an invention is the result of improper hindsight reconstruction, which is strictly forbidden by law. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442, (Fed. Cir. 1991).

We begin our analysis by examining the motivation statement proffered by the examiner in the rejection [see answer, page 4]:

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used this technique of creating the alternates before the file is requested to have modified Kikinis with the teachings of Donoho to have completed the work done by the proxy server before the HTML request was received and to have combined the two versions of the web page into one file allowing the destination computer to have chosen the display alternative. This would have allowed the requesting browser to have

received the requested data faster because the conversion of the full HTML to the reduced quality HTML would have already been performed and all that would have been required at that point would have been to have transmitted the data to the client computer [emphasis added].

We note that the motivation proffered by the examiner is not taken directly from the Donoho reference, but instead appears to be based upon the examiner's theory that the requesting browser would receive the requested data faster if the full and reduced versions were already combined into one file, thus avoiding the need for further conversion [emphasis added].

After performing a full text search of the entire Donoho patent, we find only one instance of the word "faster" within the Donoho disclosure [see col. 68, lines 23-35; the word "faster" is found at col. 68, line 35], as shown *infra*:

In one implementation of the advice reader, the evaluation of a clause A and B stops immediately as soon as A is determined to be false because it is not necessary to know the value of B to finish the evaluation of the phrase. As soon as A is determined to be false, the phrase A and B is known to have the value False. This scheme is referred to as conditional evaluation. There are implementations of the advice reader that do not perform conditional evaluation. These schemes always evaluate all subexpressions of an expression before inferring the value of the expression. The decision to use conditional evaluation in an implementation is based on performance considerations. Advice readers using conditional evaluation typically run faster [emphasis added].

We note that the Donoho disclosure of using conditional evaluation to enable an advice reader to run faster is not remotely related to the problem addressed by the Kikinis reference which is to enable small battery-powered portable computers, such as handheld computers, to perform sophisticated operations such as web browsing and the like [Kikinis, col. 2, lines 24-29]. Likewise, we note that the particular section of the Donoho reference

relied upon by the examiner [col. 22, lines 15-22] is silent regarding any advantages in processing speed resulting from, for example, combining a plain text message with an HTML message in the same advisory file using MIME, as discussed *supra*. While Donoho does clearly teach transmitting two different versions of the same message using MIME, we find that Donoho is silent regarding any pre-conversion of one of the versions as a means to achieve faster rendering on the display of the client.

We agree with the examiner that the use of MIME as a means to attach predefined types of content to Internet e-mail messages would have been known to one of ordinary skill in the art at the time of the invention. However, the particular motivation relied upon by the examiner of receiving the requested data faster is not found within the four corners of the Donoho reference [emphasis added]. We find that the examiner has failed to set forth a convincing line of reasoning to support his theory of motivation in terms of either the nature of the problem to be solved or in terms of the general knowledge of a person of ordinary skill.

We do not find that a reasonable motivation to combine Kikinis with the teachings of Donoho would have logically flowed from the nature of the problem to be solved, or would have otherwise fallen within the general knowledge of a person of ordinary skill in the field of the invention, who having full knowledge of the Kikinis patent would have been motivated to look to Donoho to select particular elements, and to combine them as combined by appellants [emphasis added]. Indeed, we find that Donoho is silent regarding any disclosure that specifically addresses the problem of how to display HTML web pages on small portable handheld computers with limited display capabilities. We therefore agree with appellants

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that the examiner has impermissibly used the instant invention as a template or guide to piece together the teachings of Kikinis and Donoho. Accordingly, we will not sustain the examiner's rejection of any of the claims under appeal.

We note that Appellants have argued two sets of dependent claims separately from the first argued group of all pending claims [brief, pages 6 and 7]. Because we agree with appellants that independent claims 4, 9, 14, and 23 are not rendered obvious by Kikinis in view of Donoho, and because all of the argued dependent claims depend directly or indirectly upon one of independent claims 4, 9, 14, or 23, we need not reach the questions presented by appellants with respect to these dependent claims. Accordingly, we will not sustain the examiner's rejection of these dependent claims for the same reasons discussed *supra* with respect to representative claim 14.

For at least the aforementioned reasons, we agree with appellants that the examiner has failed to meet his/her burden of presenting a *prima facie* case of obviousness. In summary, we will not sustain the examiner's rejection of any of the claims on appeal.

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Therefore, the decision of the examiner rejecting claims 4-18 and 23-34 is reversed.

REVERSED



KENNETH W. HAIRSTON
Administrative Patent Judge



JERRY SMITH
Administrative Patent Judge



HOWARD B. BLANKENSHIP
Administrative Patent Judge

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) **APPEALS AND**
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